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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,758	12/21/1998	GARY ANTHONY JUBB	M8540/185343	3326

7590

02/27/2003

JOHN S PRATT
KILPATRICK & STOCKTON
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309-4530

EXAMINER

GROUP, KARL E

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/202,758

Applicant(s)

Jubb et al

Examiner

Karl Group

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 10, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1755

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-10-03 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 12 are considered to be outside the scope of claim 8 because the claims clearly set forth both P_2O_5 and B_2O_3 as optional components. A dependent claim must further limit the claim from which it depends from.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Jensen et al (US 5,691,255; 5,614,449; WO 95/29135).

See examples 1-4 which fall within the ranges of the claims.

Applicants argument that Jensen et al fail to teach the relationship between P_2O_5 and B_2O_3 and the effect of increasing the refractoriness is not persuasive in overcoming the rejection. Th e

Art Unit: 1755

only active process step in the instant claims is adding one or more of P_2O_5 and B_2O_3 to a glass fiber composition. If P_2O_5 and B_2O_3 are present in the composition of Jensen et al then they would have been added thus meeting the limitations of the claimed process. In reference to any difference in the properties of the formed product, products of identical compositions may not have mutually exclusive properties, In re Spada 15 USPQ2d 1655,1658 (Fed. Circ. 1990).

6. Claims 8,9,13,14 are rejected under 35 U.S.C. 102(b) as being anticipated by Thelohan et al (US Re. 35,557 or 5,250,488).

See Ex. 3 in Table 1.

Applicants argument that there is a world of difference between insulating a duct, grill as in Thelohan et al and a furnace or kiln as in the instant invention is not persuasive in overcoming the rejection. Firstly applicants are not claiming a method of insulating a furnace or kiln but a method involving adding P_2O_5 and B_2O_3 to a glass composition which active process steps are met by the compositions of Thelohan et al. Secondly the instant disclosure is silent as to using the glass fibers of the instant invention in a furnace or kiln.

7. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Karppinen et al US 5,843,854 and WO 92/09536.

See compositions Ia and A in the Tables of column 3, 4 respectively.

Applicants argue that Karppinen et al were not concerned with refractoriness. This is not persuasive since column 1, lines 14-15 recited for "heat insulation". Again the method steps only require the mere presence or inclusion of certain compounds.

Art Unit: 1755

8. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Holstein et al (US 6,060,414; 6,037,284 and WO 93/22251.


Holstein et al '414 '284 and WO see Table 1, examples 2-6.

Applicants argue that Holstein is not concerned with refractoriness which is not persuasive in overcoming the rejection. The method claims require the mere inclusion of the components which Holstein teaches. Furthermore applicants have not shown by way of tangible evidence any difference in properties between the compositions of the prior art and the instant invention that is commensurate in scope with the instant claims

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Group whose telephone number is (703)308-3821. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703)308-3823. The fax phone number for this Group is (703)872-9310, for any non-final amendment or communication, and (703)872-9311 for any after-final amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.


KARL GROUP
PRIMARY EXAMINER
ART UNIT 1755

Keg
February 26, 2003